THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte KENNETH P. RILEY

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Appeal No. 96-0023
Application 07/958,046[1]

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ON BRIEF

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Before HAIRSTON, BARRETT and FLEMING, ***Administrative Patent Judges***.

FLEMING, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 5, all of the claims present in the application.

[1]Application for patent filed October 5, 1992.

The invention relates to a computer-based process controller including graphical display of selected process attributes.

The independent claim 1 is reproduced as follows:

> 1. A method of generating graphical display of process attributes in a computer-based process controller, comprising:
>
> storing a history of underlying process attributes for a plurality of points in time during the operation of a process being controlled;
>
> displaying a graphical representation of said process being controlled;
>
> selecting a portion of the graphical representation and a point in time for which underlying process attributes from said history are to be displayed; and
>
> displaying said underlying process attributes of the selected portion of the graphical representa-tion for the selected point in time, substantially simultaneous with the display of said graphical representation.

The Examiner relies on the following references:

Hitchens et al. (Hitchens) 4,512,747 Apr. 23, 1985

Nigawara et al. (Nigawara) 0,389,132 Sep. 26, 1990
(European Patent)

Knoop et al., "Optimal Person-Machine Interface for the

Control of Electric Power Grids", Elektrotechnische Zeitschrift, Vol. 109 no. 12 (June 1988), pp. 532-537 (English Translation pp. 1-24) (Knoop)

Thalimer, "Design of a Continuous Miner Motor Monitoring System", Conference Record of the IEEE Industry Applications Society Annual Meeting (Cat. No. 89CH2792-0)(1989), pp. 1576-1579
(Thalimer)

In the final action, claims 1 through 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hitchens and Thalimer. On page 4 of the answer, the Examiner withdraws the rejection of claims 1 through 4 under 35 U.S.C. § 103 as being unpatentable over Hitchens and Thalimer. The Examiner set forth a new ground of rejection of claims 1 through 4 under 35 U.S.C. § 103 as being unpatentable over Hitchens, Thalimer, Nigawara and Knoop[2]. Therefore, Claims 1 through 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hitchens, Thalimer, Nigawara and Knoop and claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hitchens and Thalimer.

[2]The Appellant filed an amendment to claim 1 in response to the new ground of rejection. The Examiner did not enter this amendment. Therefore, for the purpose of this appeal, this amended claim 1 is not before us for our consideration.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the briefs[3] and answers[4] for the respective details thereof.

OPINION

After a careful review of the evidence before us, we do not agree with the Examiner that claims 1 through 5 are properly rejected under 35 U.S.C. § 103.

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or

[3]Appellant filed an appeal brief on January 20, 1995. We will refer to this appeal brief as simply the brief. Appellant filed a response to the new ground of rejection (a reply appeal brief) on June 23, 1995. We will refer to this response as the reply brief.

[4]The Examiner responded to the brief with an Examiner's answer, mailed April 20, 1995. We will refer to the Examiner's answer as simply the answer. We note that the answer contains a new ground of rejection rejecting claims 1 through 4 under 35 U.S.C. § 103 as being unpatentable over Hitchens, Thalimer, Nigawara and Knoop. The Examiner responded to the reply brief with a supplemental Examiner's answer, mailed April 12, 1996. We will refer to the supplemental Examiner's answer as simply the supplemental answer.

suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied,*** 117 S.Ct. 80 (1996) ***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984).

In regard to the rejection of claim 5 as being unpatentable over Hitchens and Thalimer, Appellants argue on pages 12 through

15 of the brief and pages 2 through 5 of the reply brief that neither Hitchens nor Thalimer teaches or suggests an historical data file in which stored historical data related to process attributes underlying each of the plurality of process elements for a plurality of points in time, a mask data file including information which relates the historical

data to corresponding process elements in at least one graphical representation and a data processor to produce a combined display of at least one graphical representation with process attributes underlying at least one of the plurality of process components for a selected point of time as recited in Appellant's claim 5. Appellants argue in the reply brief that the Examiner's argument that either Hitchens or Thalimer implicitly teach these limitations is not supportable in view of the teachings of these references.

For a reference to "inherently" disclose an invention it must be shown that the missing descriptive matter is necessarily present in the thing described in the reference, and that it be so recognized by persons skilled in the art. ***Continental Can Co. USA, Inc. V. Monsanto Co.***, 948 F.2d 1264, 1268-69, 20 USPQ 1746,

1749 (Fed. Cir. 1991). Inherency may not be established by probabilities or possibilities. ***Id.***

Upon our review of Hitchens and Thalimer, we fail to find that these references implicitly teach an historical data file in which stored historical data related to process attributes underlying each of the plurality of process elements for a plurality of points in time, a mask data file including information which relates the historical data to corresponding process elements in at least one graphical representation and a data processor to produce a combined display of at least one graphical representation with process attributes underlying at least one of the plurality of process components for a selected point of time. In particular, we fail to find that Thalimer implicitly teaches displaying data for selected data points for a selected point of time or that Hitchens implicitly teaches a mask data file that is a data structure that defines the structure records in the historical data file to allow the display of process attributes of a process component for a selected point in time.

Hitchens teaches in column 1, lines 28-35, that the

purpose of their invention is to simulate the actual material conveying system so that a system designer can observe system operation prior to operation. Hitchens does not contemplate the need to record historical data for an actual system. We agree with the Examiner that Hitchens does suggest that their system could be used to monitor an actual system in operation, however, Hitchens only suggests providing real time data and not maintaining a historical record.

Thalimer teaches continuous monitoring of a miner moter for the purpose of calculating deterioration values for the insulation of the motor. Thalimer does teach maintaining a historical record of the calculated deterioration values and displaying this history. Further, Thalimer does not contemplate displaying these deterioration values for only a selected point of time or providing a mask file to correspond these values to a graphical representation so as to allow a combined display of the graphical representation with these deterioration values for a selected point in time.

Furthermore, we fail to find any reason to modify Hitchens to obtain Appellant's invention. The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability. ***In Re Denis Rouffet***, 97-1492 (Fed. Cir.

decided July 15, 1998).

Turning to the Examiner's rejection of claims 1 through 4 as being unpatentable over Hitchens, Thalimer, Nigawara and Knoop, we fail to find that the references teach or suggest selecting a stored history of underlying process attributes for a plurality of points in time during the operation of a process being

controlled, selecting a portion of the graphical representation
and a point in time for which the underlying process attributes for the history are displayed and displaying the underlying process attributes of the selected portion of the graphical
representation for the selected point in time, substantially simultaneous with the display of the graphical representation. Furthermore, we fail to find any suggestion by these references to modify Hitchens to obtain Appellant's claimed invention.

As shown above, the Examiner has not shown that Hitchens

or Thalimer teaches or suggests selecting a point of time for displaying the historical attributes of a selected portion of the graphical representation and displaying simultaneously the selected underlying process attributes and the graphical representation. Furthermore, we fail to find that Nigawara or Knoop supply this missing teaching or suggestion. In particular, neither Nigawara nor Knoop teaches or suggests a selection of a point in time for which the underlying process attributes from the history are to be displayed.

We have not sustained the rejection of claims 1 through 5 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

Reversed

KENNETH W. HAIRSTON)
Administrative Patent Judge)

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LEE E. BARRETT	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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MICHAEL R. FLEMING	)	
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